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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,997	09/16/2003	Thomas P. Jerussi	0701.182A	1742
2264 7590 02/21/2007 HESLIN ROTHENBERG FARLEY & MESITI P.C. 5 COLUMBIA CIRCLE ALBANY, NY 12203			EXAMINER WANG, SHENGJUN	
			ART UNIT	PAPER NUMBER
			1617	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/21/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/662,997

Applicant(s)

JERUSSI ET AL.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on November 22, 2006

2. Applicant's election without traverse of invention group VI, claims 9-10 in the reply filed on November 22, 2006 is acknowledged.

Claim Rejections 35 U.S.C. 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Welch, Jr, et al. (US 4,556,676, IDS, and US 4,536,518), in view of Liu et al. and Quallich (US 5,750,794)

5. Welch Jr. et al. teaches Cis and Trans-N-methyl-4-(3,4-dichlorophenyl)-1,2,3,4-tetrahydro-1-naphthalenamine, including each of the enantiomers, exhibit antidepressant and anorectic activity in vivo in mammals, including human beings. See particularly, the abstracts and the claims. Welch Jr. et al. also teach process of making the compounds, wherein 4-(3,4-Dichlorophenyl)-3,4-dihydro-1-(2H)-naphthalenone (a racemic mixture) is a key intermediate for the synthesis of the compounds. 4-(3,4-Dichlorophenyl)-3,4-dihydro-1-(2H)-naphthalenone reacts with amine to yield the N-methyl-4-(3,4-dichlorophenyl)-1,2,3,4-tetrahydro-1-

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naphthalenamine. See, particularly, the scheme in columns 3-6 in '676. Welch Jr. et al. further teach the separation of diastereomers (cis vs. trans) by method known to those skilled in the art, e.g. fractional crystallization or chromatography. Welch Jr. et al. also teach the resolution of the racemic isomers with optically active selective precipitant acid. See, particularly, column 8, line 67 to column 9, line 25 in '676.

6. Welch Jr. et al. do not teach expressly the compounds herein, which is a condensation product of 4-(3,4-Dichlorophenyl)-3,4-dihydro-1-(2H)-naphthalenone and a chiral alkylsulfonamide.

7. However, Liu et al. teaches an asymmetric tert-butanethiolamide, which provides an ideal auxiliary for asymmetric synthesis of amine functionality from a carbonyl group. Particularly, the asymmetric tert-butanethiolamide can react with a carbonyl group to form a chiral tert-butanethiolimine. See the entire document. Particularly, pages 9914. Quallich is cited to show that the skilled artisan is motivated to make chiral 4-(3,4-Dichlorophenyl)-3,4-dihydro-1-(2H)-naphthalenone, and use the technique that transfer a racemic mixture into a diastereomeric mixture followed by separation of the diastereomeric mixture is known in the art for resolution of the racemic isomers. See, particularly, the abstract, and columns 6-7.

8. Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to make the condensation product of 4-(3,4-Dichlorophenyl)-3,4-dihydro-1-(2H)-naphthalenone and a chiral alkylsulfonamide herein.

9. A person of ordinary skill in the art would have been motivated to make the condensation product of 4-(3,4-Dichlorophenyl)-3,4-dihydro-1-(2H)-naphthalenone and a chiral alkylsulfonamide herein because it is desirable in the art to make pure diastereomer and pure

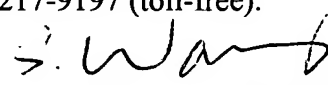
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enantiomer of N-methyl-4-(3,4-dichlorophenyl)-1,2,3,4-tetrahydro-1-naphthalenamine, and the particular compounds herein is view as an intermediate for an asymmetric product. Further, the condensation introduces an additional chiral center to the originally racemic mixture, and transform the racemic mixture into a mixture of a pair of diastereomers, which may be separated with by method known to those skilled in the art (see Welch Jr. column 8, line 67 to column 9, line 25 in '676).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Shengjun Wang
Primary Examiner
Art Unit 1617

SHENGJUN WANG
PRIMARY EXAMINER